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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/884,549 | 06/19/2001 | Michael J. Lemon | 10007916-1 | 2371 |

7590 06/06/2008
HEWLETT-PACKARD COMPANY
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| EXAMINER |
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KUMAR, SRILAKSHMI K

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| ART UNIT | PAPER NUMBER |
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2629

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| MAIL DATE | DELIVERY MODE |
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06/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 09/884,549 | Applicant(s) LEMON, MICHAEL J. | |
| | Examiner SRILAKSHMI K. KUMAR | Art Unit 2629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-15, 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following office action is in response to the Appeal Brief filed on March 5, 2008. Claims 1-3, 5-15, 17-20 are pending. The finality of the previous office action has been withdrawn.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 is directed to “a computer memory comprising computer code” which is directed to non-statutory subject matter as not being tangibly embodied in a manner so as to be executable.

According to the USPTO Interim Guidelines for Patent Subject Matter Eligibility, computer programs are neither computer components nor statutory processes, as they are not “acts” being performed nor do they define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. Applicant is directed to pages 53-56 of the USPTO Interim Guidelines for Patent Subject Matter Eligibility for further information on the current guidelines and statutory subject matter.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clary (US Patent No. 7,091,959) in view of Borgström et al (US 6,738,053) and further in view of de Hond (US 6,002,853).

In reference to claims 1 and 5, Clary teaches a computer annotator system (Fig. 2) for accessing Internet data addresses (col. 14, lines 55-59, col. 15, lines 25-27 and col. 20, lines 33-37, teaching addresses, email address and web based addresses), the system comprising, an electronic tablet having a screen (Fig. 2, item 280) with plural predefined regions that receive handwritten notations (Fig. 2, item 280, the screen with a preprinted form; Fig. 3, teaches the regions for the handwritten notations) that are hints for different internet data addresses (Fig. 3, shown by the email region); a marking stylus associating the plural predefined regions with the internet data addresses (Fig. 2, item 290, col. 14, lines 11-17). Clary does not teach mnemonic symbols. In a similar field of endeavor, Borgström et al teach a system and method for internet data entry and navigation. In Fig. 1, Borgström et al teach an electronic pen (item 10) and a writing tablet (item 12). In Figs. 12, Borgström et al teaches the tablet where the electronic pen is used to handwrite information. In col. 6, lines 57-67, Borgström et al teaches accessing a webpage by handwriting mnemonic hints, such as writing YAHOO corresponds to the full URL. Borgström et al teaches using abbreviated hints for different websites. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of using handwritten mnemonic hints for internet addresses as taught by Borgström et al into Clary as the shortcut hints enable quick entry for the user.

Clary does not disclose wherein subsequently accessing one of a predefined regions with said stylus triggers a shift, on a display separate from the tablet, to one of said internet data addresses associated with a handwritten mnemonic hint in the one of the predefined regions. De Hond discloses in col. 2, lines 45-65, wherein electronic forms and documents are provided with hyperlinks, and by clicking or selecting the hyperlinked terms or graphics, you are taken to a webpage. It would have been obvious to one of ordinary skill in the art to include hyperlinks as the mnemonic notations of internet data addresses as taught by De Hond into the computer annotator system of Clary as the hyperlinks of de Hond provide relevant information of the data addresses to the user in an expedited way (de Hond, col. 2, lines 45-65).

In reference to claim 5, Clary teaches a method for indexing computer-accessible Internet sites (Fig. 2), the method comprising accessing a first of sites (col. 14, lines 55-59, col. 15, lines 25-27 and col. 20, lines 33-37, teaching addresses, email address and web based addresses); accessing a second of said sites (col. 14, lines 55-59, col. 15, lines 25-27 and col. 20, lines 33-37, teaching addresses, email address and web based addresses). Clary teaches in Fig. 2, item 280, the screen with a preprinted form; Fig. 3, teaches the regions for the handwritten mnemonic notations and where the regions have handwritten mnemonic notations/hints in Fig. 2, item 290, col. 14, lines 11-17. Clary does not teach mnemonic symbols. In a similar field of endeavor, Borgström et al teach a system and method for internet data entry and navigation. In Fig. 1, Borgström et al teach an electronic pen (item 10) and a writing tablet (item 12). In Figs. 12, Borgström et al teaches the tablet where the electronic pen is used to handwrite information. In col. 6, lines 57-67, Borgström et al teaches accessing a webpage by handwriting mnemonic hints, such as writing YAHOO corresponds to the full URL. Borgström et al teaches using abbreviated

Art Unit: 2629

hints for different websites. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of using handwritten mnemonic hints for internet addresses as taught by Borgström et al into Clary as the shortcut hints enable quick entry for the user. Clary does not teach associating an address indicative of the first of said sites with a first location coordinate address on a computer writing tablet via a first handwritten mnemonic symbol that is a user recognizable hint for the first of said sites, the hint for the first of said sites being on a first random location on said writing tablet during access of said first of said sites or associating an address indicative of the second of said sites with a second location coordinate address on the computer writing tablet via a second handwritten mnemonic symbol that is a user recognizable hint for the second of said sites, the hint for the second of said sites being on a second random location on said writing tablet during access of said second of said sites. De Hond discloses in col. 2, lines 45-65, wherein electronic forms and documents are provided with a plurality of hyperlinks, and by clicking or selecting the hyperlinked terms or graphics, you are taken to a webpage, teaching where a website address is associated by hyperlinking. Thus, teaching associating a first of said sites with a first location coordinate address and a second of said sites with a second location coordinate address. It would have been obvious to one of ordinary skill in the art to include hyperlinks as the mnemonic notations of internet data addresses as taught by De Hond into the computer annotator system of Clary as modified by Sharif as the hyperlinks of de Hond provide relevant information of the data addresses to the user in an expedited way (de Hond, col. 2, lines 45-65).

In reference to claims 8, 11, 15 and 17, see limitations of claims 1 and 5, above.

In reference to claims 2 and 3, Clary teaches that the tablet having at least one predetermined first surface region accessible to stylus wherein annotating function commands are implemented (Fig. 2, item 280 is the tablet where function commands are input) and a predetermined second surface region accessible to stylus wherein freehand symbols indicative of the preselected data address are entered (Fig. 3, where freehand written symbols are entered into the regions).

In reference to claim 6, de Hond teaches continuing said method for a plurality of computer accessible internet sites other than said first and said second as long as there is available space for further handwritten mnemonic symbols (col. 2, lines 45-65).

In reference to claim 7, Clary discloses erasing a said handwritten mnemonic symbol on said writing tablet (col. 9, lines 23-31). Clary in col. 6, lines 16-31, disclose when deleting and editing can be accomplished by the user at any time. De Hond discloses in col. 2, lines 45-65 hyperlinking for the handwritten mnemonic symbol in order to associate the hint with an address indicative of a computer accessible internet site.

In reference to claim 9, Clary teaches a method of predefining specific locations on said tablet with data indexing functions (Fig. 3).

In reference to claim 10, Clary discloses erasing each said mnemonic object for disassociating a location from the current one of said computer data addresses associated therewith (col. 9, lines 16-31)

In reference to claim 12, Clary teaches that the method provides writing table function keys on said computer writing tablet (Fig. 2).

In reference to claim 13, de Hond teaches defining the screen as a coordinate system with plural locations, each location being a temporary bookmark for an internet site (col. 2, lines 45-65).

In reference to claim 14, de Hond teaches automatically alternating access between a plurality of addresses accessed and associated with mnemonic devices by alternating current selection between said mnemonic devices with a writing tablet writing instrument (col. 2, lines 45-65).

In reference to claim 18, de Hond teaches defining the screen as a coordinate system with plural locations, each location being a temporary bookmark for an internet site (col. 2, lines 45-65).

In reference to claim 19, de Hond teaches that the bookmarks are temporary representation of coordinates on said writing tablet (col. 2, lines 45-65).

In reference to claim 20, de Hond teaches that the bookmarks activates a jump from a current internet site address to an internet site associated with another selected one of said bookmarks (col. 2, lines 45-65).

Response to Arguments

3. Applicant's arguments, see Appeal Brief, filed March 5, 2008, with respect to the rejection(s) of claim(s) 1-3, 5-15, 17-20 under 35 USC 103, Clary in view of Sharif and further in view of de Hond have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Clary in view of Borgström et al and further in view of de Hond.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SRILAKSHMI K. KUMAR whose telephone number is (571)272-7769. The examiner can normally be reached on 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Lefkowitz can be reached on 571 272 3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sumati Lefkowitz/
Supervisory Patent Examiner, Art Unit 2629

Srilakshmi K Kumar
Primary Examiner
Art Unit 2629

SKK
June 2, 2008